

## **REMARKS**

Claims 1-10 are pending in this application.

Claims 1-6, 8, and 10 are rejected.

Claims 7 and 9 are objected to.

Claim 1 has been amended to indicate specific components for the colorant composition and for the tinting composition. Support for the amendment is found in the specification on page 4, line 20 to page 5, line 6.

Claim 6 has been amended to incorporate the subject matter of claim 7 into claim 6.

Claims 8, 9, and 10 have been amended to provide proper dependency and/or antecedent basis.

Claims 11-15 have been introduced. Support for claim 11 is found in the specification on page 7, lines 28-29. Support for claims 12-14 is found in the specification on page 7, lines 28-29 and page 9, lines 13-28. Support for claim 15 is found in the specification on page 4, line 20 to page 5, line 6.

Claims 16-17 have been introduced. Support for these claims is found in the specification on page 4, lines 23-29.

The amendments do not introduce new subject matter.

## **Rejection of Claims 1-5 under 35 U.S.C. 102(b) in view of US 5,137,571**

The Examiner has rejected claims 1-5 under 35 U.S.C. 102(b) as being anticipated by US Patent 5,137,571 to Eisenhart et al ("Eisenhart"). According to the Examiner, Eisenhart discloses compositions containing the instantly claimed ingredients and amounts thereof; and may be mixed with another paint to "tint" it.

Paints contain a mixture of ingredients including binder, as is known in the art. For example, the specification discloses that the base paint contains polymer binder (page 8, lines 10-27). In amended claim 1, the tinting composition consists essentially of at least one colorant composition and at least one additive, but does not include binder. Further, the at least colorant

composition consists essentially of certain materials but does not include binder. Therefore, the tinting composition of amended claim 1 is not anticipated by the binder containing paint compositions disclosed in Eisenhart.

The Applicant respectfully requests withdrawal of the rejection of claims 1-5 under 35 U.S.C. 102(b) in view of Eisenhart.

### **Rejection of Claims 1, 3, 5-6, 8, and 10 under 35 U.S.C. 102(b) in view of US 3,917,556**

The Examiner has rejected claims 1, 3, 5-6, 8 and 10 under 35 U.S.C. 102(b) as being anticipated by US Patent 3,917,556 to Baurecht et al ("Baurecht"). According to the Examiner, Baurecht discloses the instantly claimed tinting compositions and their addition to paint.

In amended claim 1, the tinting composition consists essentially of at least one colorant composition and at least one additive, but does not include binder. Further, the at least colorant composition consists essentially of certain materials but does not include binder. In contrast, the pigment paste composition of Baurecht is disclosed to contain 3 to 20 weight % of a binder (col. 1, lines 41-43). Therefore, the tinting composition as claimed in claims 1, 3, and 5 is not anticipated by the binder containing pigment paste compositions of Baurecht.

The examiner has stated that claim 7 is object to as being dependent upon a rejected base claim. Claim 6 has been amended to include the subject matter of claim 7, and as such, the method of claim 6 and dependent claims 8-10 are not anticipated by Baurecht.

The Applicant respectfully requests withdrawal of the rejection of claims 1, 3, 5-6, and 8-10 under 35 U.S.C. 102(b) in view of Baurecht.

### **Conclusions**

The Applicant respectfully requests the Examiner to withdraw the rejection of claims 1-5 under 35 U.S.C. 102(b) in view of Eisenhart; to withdraw

the rejection of claims 1, 3, 5-6 and 8-10 under 35 U.S.C. 102(b) in view of Baurecht; and to pass claims 1-6 and 8-17 to allowance.

Respectfully submitted,



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